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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,324	04/13/2004	Franklin Fulton Simpson	BEAS-1260US2	4474
23910 7590 05/07/2007 FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			EXAMINER MITCHELL, JASON D	
			ART UNIT 2193	PAPER NUMBER
			MAIL DATE 05/07/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/823,324

Applicant(s)

SIMPSON, FRANKLIN FULTON

Examiner

Jason Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-16 are pending in this application.

### *Drawings*

2. **The drawings are objected to under 37 CFR 1.83(a) because they do not include items labeled 410, 420, 430 and 440 as described in the specification (see par. [0026]).**
3. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

4. **Claims 5 and 13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.**

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 5 is exemplary and recites "means for placing the .jar file in a predetermined directory within the managed server it is to reside in". Parent claim 1 recites this limitation in lines 6-7. Claim 13 is objected to for similar reasons.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 15 recites "The method of claim 14"; however parent claim 14 is directed to "A computer program product". Consequently, it is unclear if the claim is intended to be directed to a computer program product or a method.

Claim 16 has similar problems.

7. **Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

8. **Claim 1 recites the limitation "the generated MBean types" in line 4.** There is insufficient antecedent basis for this limitation in the claim.

9. **Claim 1 recites the limitation "the server" in line 8.** There is insufficient antecedent basis for this limitation in the claim, in that it is not clear that the limitation is intended to refer to the "managed server" recited in line 4.

10. **Claim 2 recites the limitation "an MBean definition file" in line 3.** It is not clear if this is intended to represent the MBean definition file recited in line 2 of claim 1.

11. **Claim 4 recites the limitation "an MBean type" in line 2.** It is not clear if this is intended to represent one of the "generated MBean types" recited in line 4 of claim 1.

12. **Claim 5 recites the limitation "a predetermined directory" in line 3.** It is not clear if this is intended to represent the "predetermined directory" recited in line 5 of claim 1.

13. **Claim 6 recites the limitation "the parsed mdf" in line 3.** There is insufficient antecedent basis for this limitation in the claim.

14. **Claim 9 recites the limitation "the generated MBean types" in line 5.** There is insufficient antecedent basis for this limitation in the claim.

15. **Claim 9 recites the limitation "the server" in line 9.** There is insufficient antecedent basis for this limitation in the claim, in that it is not clear that the limitation is intended to refer to the "managed server" recited in line 5.

16. **Claim 10 recites the limitation "an MBean definition file" in line 3.** It is not clear if this is intended to represent the MBean definition file recited in line 2 of claim 1.

17. **Claim 12 recites the limitation "an MBean type" in line 2.** It is not clear if this is intended to represent one of the "generated MBean types" recited in line 5 of claim 9.

18. **Claim 13 recites the limitation "a predetermined directory" in line 3.** It is not clear if this is intended to represent the "predetermined directory" recited in line 6 of claim 9.

19. **Claim 14 recites the limitation "the parsed mdf" in line 4.** There is insufficient antecedent basis for this limitation in the claim.

Claims dependent on the claims above, which may not have explicitly recited antecedent basis issues, inherit the antecedent basis issues of the parent claims and are rejected accordingly.

### ***Claim Rejections - 35 USC § 101***

20. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 9-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 9 and 14 are directed to computer program products comprising only 'computer code' and thus recite only software per se. Claims 10-13 and 15-16 do not correct this issue.

Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Note that while claims 15 and 16 respectively recite "The method of claim 14" and "The method of claim 15". This language only serves to make the claims unclear (see above) and thus does not constitute a recitation of something other than 'software'.

### ***Double Patenting***

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**22. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/823,290. Although the conflicting claims are not identical, they are not patentably distinct from each other because:**

**23. Claims 1-8 and 9-16 of the instant application are each, respectively, rejected over claims 1-8 of the '290 application.**

While claims 1-8 of the '290 application are directed to a method, and claims 1-8 and 9-16 of the instant application are directed to a computer-readable medium and a computer program product, respectively, the claims are otherwise recite the same scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



***Claim Rejections - 35 USC § 102***

24. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

25. **Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by US 7,206,827 to Viswanath et al. (Viswanath).**

26. **Regarding Claims 1 and 9:** Viswanath discloses a computer-readable medium, comprising:

means for receiving an MBean definition file (col. 15, lines 33-35 “a meta-information file may be generated by users”; col. 20, lines 9-10 “the management beans 212 generated ... may be MBeans”)

means for generating an MBean .jar file (col. 20, lines 9-10 “the management beans 212 generated ... may be MBeans”; col. 10, lines 3-5 “deployed applications may be stored ... as jar files”)

means for installing the generated MBean types into a managed server within a management system (col. 15, lines 45-48 “Deployment may include implementing beans 250 ... on servers 202 to which the server system is to be deployed”);

means for placing the .jar file in a predetermined directory within the managed server it is to reside in (Fig. 3, Persistent Store 204; col. 20, lines 9-10 “the management beans 212 ... may be MBeans”; Note that MBeans contain a ‘persistLocation’ descriptor field indicating The fully qualified directory where files representing the MBean should be stored.); and

means for starting the server (col. 15, lines 45-48 “Deployment may include implementing beans 250”).

27. **Regarding Claims 2 and 10:** The rejection of claims 1 and 9 are incorporated; respectively; further, Viswanath discloses means for receiving an MBean definition file includes: means for receiving an MBean definition file in .XML format (col. 9, lines 14-20 “generate an administration framework from ... an XML file”).

28. **Regarding Claims 3 and 11:** The rejection of claims 1 and 9 are incorporated; respectively; further, Viswanath discloses means for generating an MBean .jar file includes:

means for generating the MBean .jar file from the .MBean definition file (col. 9, lines 14-20 “generate an administration framework from ... an XML file”).

29. **Regarding Claims 4 and 12:** The rejection of claims 1 and 9 are incorporated; respectively; further, Viswanath discloses the MBean .jar file includes data-related to

installing an MBean type into a web service infrastructure (col. 10, lines 3-6 “with application configuration info within the jar files”).

30. **Regarding Claims 5 and 13:** The rejection of claims 1 and 9 are incorporated; respectively; further, Viswanath discloses means for installing the generated MBean types into a managed server within a management system includes:

means for placing the .jar file in a predetermined directory within the managed server it is to reside in (Fig. 3, Persistent Store 204; col. 20, lines 9-10 “the management beans 212 ... may be MBeans”).

31. **Regarding Claims 6 and 14:** Viswanath discloses a generating an MBean .jar file, comprising:

means for parsing an MBean definition file (col. 24, lines 39-40 “parsers for XML data”). ;

means for generating files from the parsed mdf (col. 9, lines 14-20 “generate an administration framework from ... an XML file”). ); and

means for compiling and storing the files in a .jar file (col. 14, lines 27-30 “the administration framework may be compiled”; col. 10, lines 3-5 “deployed applications may be stored ... as jar files”).

32. **Regarding Claims 7 and 15:** The rejection of claims 6 and 14 are incorporated; respectively; further, Viswanath discloses:

means for configuring the files to provide custom attribute implementations (col. 9, lines 13-21 "meta-information 226 ... includes descriptions of elements or properties, and their attributes").

33. **Regarding Claims 8 and 16:** The rejection of claims 7 and 15 are incorporated; respectively; further, Viswanath discloses means for configuring includes means for editing the files generated from the parsed MBean definition file (col. 14, lines 31-33 "A user may ... edit a user property").

### ***Conclusion***

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Mitchell whose telephone number is (571) 272-3728. The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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